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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/476,415	12/30/1999	DALE SANDBERG	3855.29	7821

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EXAMINER

BLECK, CAROLYN M

ART UNIT PAPER NUMBER

2166

DATE MAILED: 04/02/2002

Please find below and/or attached an Office communication concerning this application or proceeding.

**Office Action Summary**

Application No.

09/476,415

Applicant(s)

SANDBERG, DALE

Examiner

Carolyn M Bleck

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-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

**Period for Reply**

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133).
- Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

**Status**

- 1) ☒ Responsive to communication(s) filed on 30 December 1999.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

**Disposition of Claims**

- 4) ☒ Claim(s) 1-20 is/are pending in the application.
- 4a) Of the above claim(s) \_\_\_\_\_ is/are withdrawn from consideration.
- 5) ☐ Claim(s) \_\_\_\_\_ is/are allowed.
- 6) ☒ Claim(s) 1-20 is/are rejected.
- 7) ☐ Claim(s) \_\_\_\_\_ is/are objected to.
- 8) ☐ Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

**Application Papers**

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☒ The drawing(s) filed on 30 December 1999 is/are: a) ☐ accepted or b) ☒ objected to by the Examiner.
- Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
- 11) ☐ The proposed drawing correction filed on \_\_\_\_\_ is: a) ☐ approved b) ☐ disapproved by the Examiner.
- If approved, corrected drawings are required in reply to this Office action.
- 12) ☐ The oath or declaration is objected to by the Examiner.

**Priority under 35 U.S.C. §§ 119 and 120**

- 13) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some \* c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
2. ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
- \* See the attached detailed Office action for a list of the certified copies not received.
- 14) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. § 119(e) (to a provisional application).
- a) ☐ The translation of the foreign language provisional application has been received.
- 15) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. §§ 120 and/or 121.

**Attachment(s)**

- 1) ☒ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) ☒ Information Disclosure Statement(s) (PTO-1449) Paper No(s) 2.
- 4) ☐ Interview Summary (PTO-413) Paper No(s). \_\_\_\_\_.
- 5) ☐ Notice of Informal Patent Application (PTO-152)
- 6) ☐ Other: \_\_\_\_\_.

## **DETAILED ACTION**

### ***Notice to Applicant***

1. This communication is in response to the application filed 12 December 1999. Claims 1-20 are pending. The IDS statement filed 18 February 2000 has been entered and considered.

### ***Drawings***

2. The drawings are objected to as failing to comply with 37 CFR 1.84(p)(5) because they include the following reference sign(s) not mentioned in the description: Figure 1, 196 and 197. A proposed drawing correction, corrected drawings, or amendment to the specification to add the reference sign(s) in the description, are required in reply to the Office action to avoid abandonment of the application. The objection to the drawings will not be held in abeyance.
3. Applicant is required to submit proposed drawing corrections in response to this Office action. However, formal correction of the noted defect(s) can be deferred until the application is allowed by the examiner.

### ***Specification***

4. Applicant is reminded of the proper language and format for an abstract of the disclosure.

The abstract should be in narrative form and generally limited to a single paragraph on a separate sheet within the range of 50 to 150 words. It is important that

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the abstract not exceed 150 words in length since the space provided for the abstract on the computer tape used by the printer is limited. The form and legal phraseology often used in patent claims, such as "means" and "said," should be avoided. The abstract should describe the disclosure sufficiently to assist readers in deciding whether there is a need for consulting the full patent text for details.

The language should be clear and concise and should not repeat information given in the title. It should avoid using phrases which can be implied, such as, "The disclosure concerns," "The disclosure defined by this invention," "The disclosure describes," etc.

### ***Claim Rejections - 35 USC § 102***

5. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

6. Claims 11, 13-15, and 19 are rejected under 35 U.S.C. 102(b) as being clearly anticipated by Lavin et al. (5,772,585).

(A) As per claim 11, Lavin discloses a method for managing patient medical information and for concurrently recording patient examination and diagnoses notes in a database during patient examination (col. 1 lines 52-62) comprising:

(a) selecting available appointment slots for a patient by physician or by location in a medical clinic environment (Fig. 4, col. 4 line 1, and col. 6 lines 19-21);

(b) compiling patient data, including medical history and demographic information, based on a scheduled appointment for patients and inserting the data into a relational database (col. 6 lines 36-38, col. 16 lines 30-32);

(c) selecting a procedure viewed from a list (col. 13 lines 51-54);

(d) displaying a predetermined fee associated with a diagnosis and procedure (Fig. 17 and col. 13 lines 55-59); and

(e) automatically generating and printing a patient bill after an office visit, including patient information, diagnosis and procedure information, fees associated with a procedure, and insurance information (Fig. 17, col. 13 lines 16-21 and lines 55-59, and col. 22 lines 27-28).

(B) As per claim 13, Lavin discloses a method for managing and processing patient medical information in a medical clinic environment during a patient examination (col. 3 lines 5-7 and col. 3 line 66 – col. 4 line 2).

(C) As per claim 14, Lavin discloses automatically generating and printing a patient bill after an office visit, including patient information, diagnosis and procedure information, fees associated with a procedure, and insurance information (Fig. 17, col. 13 lines 16-21 and lines 55-59, and col. 22 lines 27-28).

(D) As per claim 19, Lavin discloses a system comprising a procedure list display for a physician to scroll through to select the appropriate procedure performed (col. 13 lines 24-27).

7. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

8. Claims 1-10, 12, 16-18, and 20 are rejected under 35 U.S.C. 103(a) as being unpatentable over Lavin et al. (5,772,585) in view of Smutek et al. (4,553,206).

(A) As per claim 1, Lavin discloses a comprehensive system for managing, storing, recording, and displaying patient medical information comprising:

(a) a relational database for concurrently recording examination and diagnoses notes during a patient examination, and for retrieving and manipulating patient information relating to medical procedures, diagnoses, prescriptions, costs or other variables (Fig. 21-23, col. 1 lines 57-60, col. 2 lines 52-64);

(b) an input device in communication with a processor for receiving patient data, including a keyboard, computer pen, or microphone (Fig. 1, col. 2 lines 25-30, col. 17 lines 46-47);

(c) a display in communication with a processor to view patient history and record diagnoses during an examination and to view retrieved information relating to patients in an easy-to-read format (Fig. 1, col. 10 lines 41-58, & col. 17 line 42); and

(d) a diagnosis screen displaying patient information and for recording a patient's diagnosis, procedures performed, and fees associated with the procedures,

wherein a procedure is selected and a predetermined fee is automatically displayed on the screen (Fig. 17 & col. 13 lines 8-43).

Lavin fails to expressly disclose a system, wherein a form generator is used to generate a patient visit form, and wherein a user inputs patient data, such as health history and treatments on the form contemporaneous with a record, including patient examination information, being generated.

Smutek discloses a technique for form generation wherein an image is scanned into a computer and displayed on a display screen, and wherein the image is stored on the computer, and can be retrieved, and edited, and wherein the stored image, which includes forms such as insurance forms, contains sub fields for a user to "fill in the blanks" to display information concerning a client on the display screen (col. 3 lines 39-52, col. 14 line 7, 52-55, and 57, and col. 15 lines 3-32).

At the time the invention was made, it would have been obvious to a person of ordinary skill in the art to combine Lavin's system for managing patient medical information with Smutek's technique for form generation with the motivation of rapidly and easily inserting information into a form or editing information contained within the form (Smutek; col. 14 lines 34-41), and efficiently recording and retrieving patient information to increase a physician's productivity (Lavin; col. 11 line 67 – col. 12 line 3).

(B) As per claim 2 Lavin discloses a system wherein a physician provides a physical examination to a patient, including diagnosis and medical procedures and charges a fee based on any procedures performed. (Fig. 17 and col. 13 lines 8-21 and lines 55-58).

(C) As per claim 3, Lavin and Smutek fail to expressly disclose a system, wherein a user is able to modify financial information for a patient's visit. However, Lavin discloses a display screen for a physician to record a procedure performed on a patient, wherein each procedure has a predetermined fee associated with it, and the fee is automatically displayed when a physician chooses a procedure (Fig. 17, col. 13 lines 16-21 and 55-59).

It is respectfully submitted that Lavin's fee information would be uniquely associated with a patient, and thus part of a client record. In addition, any change in entry of procedure codes in generating a bill is considered a modification of financial transaction information.

(D) As per claim 4, Lavin discloses a display screen for the physician to enter any procedures performed on a patient and the fees associated with those procedures (Fig. 17 and col. 13 lines 16-21), wherein information entered is stored in tables in a database associated with a particular screen (Fig. 17 and col. 14 lines 35-38), and wherein patient procedure and financial information input is used to automatically generate a patient bill when a physician completes an examination (col. 14 lines 55-59).

(E) As per claims 5 and 8, Lavin discloses a graphical user interface for a physician (Fig. 17) to enter a diagnosis for a patient, wherein the diagnosis information is a



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disease or medical condition (col. 13 lines 32-35), and wherein each procedure performed by a physician is associated with a diagnosis (Fig. 17).

(F) As per claim 6, Lavin discloses a system used by a physician during patient examinations, wherein a physician enters a diagnosis screen that displays patient information, and inputs diagnosis and procedure information, and fees associated with procedures (Fig. 17 and col. 13 lines 8-43). Lavin fails to expressly disclose using a form to enter the information. Smutek discloses a technique for generating a form based on a user's needs (col. 14 lines 5-13).

At the time the invention was made, it would have been obvious to a person of ordinary skill in the art to combine Lavin's system for creating a procedure history for a patient with Smutek's technique for generating a form to be filled in by a user with the motivation of allowing a physician to easily and efficiently record information reflecting a visit for each patient and providing health care specialists the flexibility to customize Lavin's system based on their needs (Lavin; col. 1 line 31, col. 4 lines 2-8). The motivation for combining Smutek into Lavin is given above in claim 1, and incorporated herein.

(G) As per claim 7, Lavin discloses a system wherein a user can generate reports (Fig. 2; col. 15 lines 47-58), and wherein a user enters insurance information relating to the patient (Fig. 8 and col. 15 lines 21-24), and is printed on a patient bill easily and automatically after an office visit (Fig. 17 and col. 13 lines 55-59).

(H) As per claims 9 and 10, Lavin discloses a graphical user interface displayed on a computer display device, wherein the graphical user interface is used to store and retrieve patient medical information held in a database, and wherein information regarding procedure history can be printed (Fig. 1 & 17, col. 2 lines 39-45, col. 4 lines 4-8, col. 16 lines 33-35, col. 19 lines 3-19, and col. 22 lines 8-28).

(I) As per claim 12, Lavin discloses a method for managing patient medical information and for concurrently recording patient examination and diagnoses notes in a database during patient examination (col. 1 lines 52-62) comprising:

- (a) recording a patient's diagnosis, using diagnosis codes such as ICD9 codes, and procedures performed, using CPT95 codes (Fig. 17 and col. 13 lines 8-43);

- (b) displaying patient information on a graphical user interface, related to the diagnosis and procedures performed on a patient (Fig. 17 and Fig. 13 lines 8-43); and

- (c) recording a patient's diagnosis, procedures performed, and fees associated with the procedures, wherein a procedure is selected and a predetermined fee is automatically displayed on the screen at the time of the examination (Fig. 17 & col. 13 lines 8-43).

Lavin fails to expressly disclose a method of using a patient visit form to keep a record of health history and treatments, wherein the form displays codes relating to diagnosis and procedures, and wherein patient data is entered on the form at the time of the visit.

Smutek discloses a technique for form generation wherein an image is scanned into a computer and displayed on a display screen, and wherein the image is stored on the computer, and can be retrieved, and edited, and wherein the stored image, which includes forms such as insurance forms, contains sub fields for a user to "fill in the blanks" to display information concerning a client on the display screen (col. 3 lines 39-52, col. 14 line 7, 52-55, and 57, and col. 15 lines 3-32).

At the time the invention was made, it would have been obvious to a person of ordinary skill in the art to combine Lavin's system for managing patient medical information with Smutek's technique for form generation with the motivation of rapidly and easily inserting information, relating to diagnosis codes and patient data, into a form, (Smutek; col. 14 lines 34-41) and efficiently recording and retrieving patient information to increase a physician's productivity (Lavin; col. 11 line 67 – col. 12 line 3).

(J) As per claim 16, Lavin and Smutek fail to expressly disclose a method for patient medical record management where the financial records recorded for the patient include billing the patient for medical inventory transferred to the patient. However, Lavin discloses a method, wherein a patient's diagnosis, procedures, and fees for those procedures are recorded on a display (Fig. 17, and col. 13 lines 8-43).

It is respectfully submitted that medical inventory is necessary to properly treat a patient and billing a patient for medical inventory is a critical component to running a medical practice, and the skilled artisan would have found it an obvious modification to have included recording medical inventory given to a patient, wherein the patient is

billed for the medical inventory at the time of a visit, so as to generate accurate billing records for a patient during the office visit (Lavin; col. 13 lines 55-59) and allow a patient to conveniently receive the necessary medical equipment for the medical procedure received.

(K) As per claims 17 and 18, Lavin and Smutek fail to expressly disclose a method for generating specific lists of data, particularly available service providers for patients and all patients seeing a particular service provider. However, Lavin discloses a method for storing patient medical information in a relational database, wherein the data stored includes tables for physician information (user\_infor, Doc\_OnOff, and Doctor\_AvailTime) (Fig. 22 and col. 5 lines 36-46, and col. 6 lines 62-65), and tables for patient information (Fig. 23), and wherein table information is stored by patient identification number, date, and physician (col. 11 lines 60-61), and wherein the graphical user interface includes a report screen (col. 2 lines 49-51) to allow a user to access and analyze patient data stored in the tables (col. 15 lines 43-57).

It is respectfully submitted that the ability to allow a user to manipulate data stored in tables and to generate reports, based on available service providers for patients and patient's seeing an individual service provider, is necessary for the management of a health care office, and the skilled artisan would have found it an obvious modification to include these reports in the system with the motivation of identifying trends in patient loads and scheduling in order to maximize efficiency and effective use of a physician's time (Lavin; col. 15 lines 55-58), and to present patients

with an understandable report of providers available to them so they may make an informed decision on their health care.

(L) As per claim 20, Lavin and Smutek fail to expressly disclose the feature of allowing a user to select from a list of appointment types when scheduling a patient appointment. However, Lavin does disclose an appointment screen wherein the user inputs into a text box a reason for an appointment and has the option to schedule routine physical examinations, and wherein the screen includes list boxes to choose physician names and locations for appointments (Fig. 4 and col. 6, lines 7-16).

It is respectfully submitted that allowing a user to choose an appointment type would increase the ease of use for the system, and the skilled artisan would have found it an obvious modification to have included a list box to choose appointment types on the graphical user interface of Lavin's system with the motivation of increasing the ease of use of the system and standardizing appointment types for easier data analysis (col. 15 lines 42-57).

### ***Conclusion***

9. The prior art made of record and not relied upon is considered pertinent to the Applicant's disclosure. The cited but not applied prior art teaches a fully computerized insurance system for processing and preparing applications for insurance and premium quotations (4,831,526); an electronic prescription creation system for use by professional prescribers at the point of care (5,737,539); an insurance estimating

system (5,839,112); a computer system and method for assisting in the administration and monitoring of patients in therapy (5,842,175); a wirelessly deployable, electronic prescription creation system for a physician (5,845,255); a medical records system to create and maintain patient data electronically (5,924,074); and a method for tracking medical supply usage on a procedure level in a clinical setting (5,991,728).

10. Any inquiry concerning this communication or earlier communications from the examiner should be directed to Carolyn Bleck whose telephone number is (703) 305-3981. The examiner can normally be reached on Monday-Friday, 8:30am – 5:00pm.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Joseph Thomas can be reached at (703) 305-9588.

Any inquiry of a general nature or relating to the status of this application or proceeding should be directed to the Receptionist whose telephone number is (703) 305-3900.

10. **Any response to this action should be mailed to:**

Commissioner of Patents and Trademarks  
Washington, D.C. 20231

**Or faxed to:**

(703) 746-7238 [After Final communications, labeled "Box AF"]

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(703) 746-7239 [Official communications]

(703) 746-7240 [Informal/ Draft communications, labeled  
"PROPOSED" or "DRAFT"]

Hand-delivered responses should be brought to Crystal Park 2, 2121 Crystal Drive, Arlington, VA, Fourth Floor (Receptionist).

CB  
CB

March 25, 2002

  
**JOSEPH THOMAS**  
**SUPERVISORY PATENT EXAMINER**  
**TECHNOLOGY CENTER 2100**